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OFFICE OF PETITIONS

In re Application of
Compton, et al.
Application No. 09/942,146
Filed: August 29, 2001
Attorney Docket No. 960296.98342

DECISION ON PETITION

This is in response to the "Response to Notice of Incomplete Nonprovisional Application," filed July 1, 2002. Therein, petitioners request that based on an incorporation by reference statement that drawings inadvertently omitted from the application be considered as filed on August 29, 2001, the date of filing of the above-identified divisional application.

Application papers in the above-identified application were filed on December 13, 2001. However, on January 14, 2002, the Initial Patent Examination Division mailed a "Notice of Incomplete Nonprovisional Application," notifying applicant that the application papers had not been accorded a filing date because the application was deposited without drawings.

In reply, petitioner filed the instant communication. Petitioner acknowledges that the drawings were inadvertently omitted at the time of filing of the application. Petitioner argues, however, that this application is a divisional application, and that the entire disclosure of the prior application, including the drawings, was incorporated by reference into the instant application, and thus, the application is entitled to a filing date of August 29, 2001. Included with the petition are three sheets of drawings.

A review of the application-as-filed reveals that it contained the incorporation by reference statement, incorporating the entire disclosure of prior application No. 09/627,986. MPEP 201.06 provides in, pertinent part, that:

Material needed to accord an application a filing date may not be incorporated by reference. Therefore, if a continuation or divisional application as originally filed incorporates by reference material omitted from the application papers, which is needed to accord the application a filing date, the application will not be entitled to a filing date. A petition under 37 CFR 1.182 and the required petition fee, including an amendment submitting the necessary omitted material, requesting that the necessary omitted material contained in the prior application and submitted in the amendment, be included in the continuation or divisional application based upon the incorporation by reference statement, is required in order to accord the application a filing date as of the date of deposit of the continuation or divisional application. An

amendment submitting the omitted material and relying upon the incorporation by reference will not be entered in the continuation or divisional application unless a decision granting the petition states that the application is accorded a filing date and that the amendment will be entered.

The instant response has been treated as a petition under \$1.182 and the required fee has been charged to Deposit Account No. 17-0055, as authorized.

Thus, petitioner has filed the required petition under \$1.182 and the required fee. However, petitioner has not submitted the required preliminary amendment requesting entry of the omitted material contained in the prior application and submitted in the amendment (e.g., three (3) sheets of drawings containing Figures 1-3).

In view thereof, the petition under \$1.182 is **DISMISSED** without prejudice to reconsideration upon the timely filing of the required preliminary amendment. Any request for reconsideration must be filed within TWO (2) MONTHS from the mailing date of this decision. This period is not extendable under 37 CFR \$1.136(a). See 37 CFR \$1.181(f).


Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
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By FAX: (703) 308-6916
Attn: Office of Petitions
Attn: Nancy Johnson¹

By hand: Office of Petitions
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Arlington, VA

Telephone inquiries related to this decision should be directed to Petitions Attorney Nancy Johnson at (703) 305-0309.


Beverly Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

¹ To facilitate quick resolution of this matter, petitioner may elect to file the preliminary amendment by facsimile communication and to telephone attorney Johnson at the time of transmission to make her aware to expect the response.